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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,934	07/10/2003	John Thomas Stites	005127.00209	9941
22909	7590	05/18/2006	EXAMINER	
BANNER & WITCOFF, LTD. 1001 G STREET, N.W. WASHINGTON, DC 20001-4597			PASSANITI, SEBASTIANO	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,934

Applicant(s)

STITES ET AL.

Examiner

Sebastiano Passaniti

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 71-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 71-86 is/are allowed.
- 6) ☒ Claim(s) 90,91,99 and 101-104 is/are rejected.
- 7) ☒ Claim(s) 92-98 and 100 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is responsive to communication received 02/28/2006 – Election.

Claims 71-118 remain pending.

Applicant's election without traverse to prosecute claims directed to the species of Figure 7 is acknowledged. Applicant has indicated that claims 71-86, 88-104 and 106-118 are readable on the elected species.

There is agreement with applicants election in that claims 87 and 105 are drawn to an embodiment wherein the weight positioning system is mounted on an exterior of the golf club head. However, upon further review, it is noted that ONLY claims 71-86 and 90-104 are readable on the elected species. Aside from claims 87 and 105, it is noted that claims 88, 89 and 106-118 are not drawn to the elected species. Claims 88 and 106, for example, are drawn to an embodiment wherein the weight includes a pair of arms that extend outward from the support and a pair of masses secured to the arms. This arrangement is in accord with that which is shown in Figure 8B. Claim 89, which depends from claim 88, and claim 106, which depends from claim 105, each further limit the weight by requiring the arms to be angled with respect to one another. Claims 108-118 clearly detail an arrangement wherein the weight includes a pair of masses secured to end areas of the arm. These claims do not reflect the species of elected Figure 7.

Thus, claims 87-89 and 105-118 stand withdrawn from further consideration as being drawn to a non-elected species. For purposes of the following Office action, claims 71-86 and 90-104 are being examined on the MERITS:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 90, 91, 99 and 101-104 are rejected under 35 U.S.C. 102(b) as being anticipated by Dutch Patent (DE 3711964 A1), already of record. Reference is made to Figures 1-12. As to claim 90, note Figure 1 showing a support (9) along with at least one weight (14, 15) moveable along and around the support. The thread markings on the support may be considered a "scale", as broadly as claimed. As to claim 91, the "scale" is positioned on the exterior of the threaded support. As to claim 99, the longitudinal support is positioned parallel to the plane of the face, as best shown in Figures 4 and 6. As to claim 101, the elongated shape of the weight dictates that the center of gravity is offset from the opening of the weight. As to claim 102, note that at least two diverse weights (14, 15) are useable. As to claim 103, the weights are clearly made of different materials, as evidenced by the diverse markings (shade, lines/cross-hatching) used to designate each of the weights. As to claim 104, the weights (14, 15) are different in shape (Figure 1).

Allowable Subject Matter

Claims 71-86 are allowable over the prior art references of record. A complete reasons for allowance will be provided at such time as the application is in condition for allowance.

Claims 92-98 and 100 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's arguments with respect to claims 71-118 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3711

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp
May 13, 2006


Sebastiano Passaniti
Primary Examiner